

Application No. 10/791,317
Attorney Docket No.: 03-019

REMARKS

Claims 1 - 20 are pending in the present application.

Claims 1, 2 and 12 are independent.

Drawing Objections

The Examiner has objected to the drawings for the following reasons:

"the illustrations of the popcorn icon being utilized and transformed on a matrix in the slot machine game as claimed in claim 1"

(Office Action, page 2)

The objection is improper for two reasons. First, it is impossible to comply with. Second, the rule that the Examiner believes provides the authority for such an objection is ambiguous and does not provide the authority supposed.

1. The Objection is Impossible to Comply With

Applicants cannot overcome the objection because it requires showing motion in a drawing, which is impossible. The Examiner appears to be requiring that the drawings show motion or other visual imagery that changes with time. This appears to be impossible, but Applicants would appreciate any suggestions that the Examiner may have for complying with the objection.

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2. Rule 1.83(a) is Ambiguous and Does Not Provide the Authority the Examiner
Supposes

The rule is ambiguous and thus cannot be accurately applied or complied with. Specifically, 37 C.F.R. § 1.83(a) is ambiguous because the term "feature" is ambiguous.

As best as the objection can be understood, the Examiner believes that the term "feature" is synonymous with "claim limitation". This is not plausible. The term "limitation" is used in many other portions of title 37 of the C.F.R. (e.g., 37 C.F.R. §§ 1.75(c); 1.141(a); 1.192; 1.965(c)(8)(iii); 1.965(c)(8)(iv); 1.965(c)(8)(v)). Thus, it is unlikely that "feature" in 37 C.F.R. § 1.83(a) is intended to mean "limitation"; if so, the word "limitation" would have been used again.

Further, in all of title 37 of the C.F.R., the word "feature" appears only twice, so its meaning is unclear. The term "feature" furthermore appears only with respect to drawings, and does not directly modify "claim". In other words, the rules do not infer that a claim has a "feature". Per the rules, inventions and drawings have "features".

The word "feature" appears in 37 C.F.R. § 1.83(a):

"The drawing in a nonprovisional application must show every feature of the invention specified in the claims"

(emphasis added)

and also in 37 C.F.R. § 1.84(q):

in a drawing lead lines "must originate in the immediate proximity of the reference character and extend to the feature indicated." (emphasis added)

Accordingly, "feature" is not synonymous with "limitation".

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3. Rule 1.83(a) is Inconsistent with Other Rules

The Examiner's interpretation of Rule 1.83(a) is inconsistent with the plain language of other rules, leaving its meaning ambiguous and in some situations impossible to enforce.

The Examiner interprets 37 C.F.R. § 1.83(a) as requiring, for every application, every recited claim limitation of every pending claim to be depicted in drawings. In other words, the Examiner's interpretation requires the application to have one, or likely more than one, drawing.

That interpretation is inconsistent with 37 C.F.R. § 1.81(a), which dictates that drawings are not required if they are not "necessary for the understanding of the subject matter sought to be patented".

Thus, the Examiner's interpretation would be contrary to the qualification plainly present in Rule 1.81(a) that drawings need not be present at all in certain circumstances.

4. Rule 1.83(a) is Contrary to Federal Circuit Precedent

It is well settled law that a claim can cover more than those embodiments which are explicitly described in the application.

Thus, Rule 1.83(a) promulgated by the PTO cannot require applicants to specify, in a drawing or in any other part of the written description, all of the embodiments which the claim is to cover. Yet that is precisely what would be required if an applicant were to describe all "claim limitations" in a drawing.

A claim limitation which can cover many different embodiments might be amenable to many different illustrations. Applicants are not obliged to recite in the application all embodiments that a claim covers.

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5. It is Unclear Whether a Drawing of a Species Can Satisfy the Purported Requirement

It is unclear whether a drawing showing a species or subset of a claim limitation can satisfy the purported requirement to show a "feature" that the Examiner interprets to be a claim limitation.

For example, if the term "transforming" can cover many embodiments (e.g., motion, animation, size change, and the like), it is unclear whether an illustration of one type of transforming would satisfy the "requirement" that the drawings show "transforming".

This again demonstrates that the Examiner's interpretation of the rule as requiring every claim limitation to be illustrated is erroneous.

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Disclosure Objections

Amendments to the specification have been made to address the typographical errors noted by the Examiner, and to insert the proper serial numbers for referenced patent applications. No new matter has been introduced by any amendment.

Claim Amendments

Claim 2 has been amended to incorporate the limitations of originally-filed claim 3, which has been canceled. Thus, claim 2 as amended is identical in scope to claim 3 as filed.

Claim 12 has been amended to incorporate the limitations of originally-filed claim 16, which has been canceled. Thus, claim 12 as amended is identical in scope to claim 16 as filed.

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Section 112, ¶ 1 Rejections

Claims 6, 19 and 20 stand rejected as failing to comply with the enablement requirement. Applicants traverse the Examiner's Section 112 rejection. No *prima facie* showing of a lack of enablement has been made.

The only reasoning provided for this rejection is:

"the limitations of generating/determining the payout based on outcomes having respective positions which defines [sic] a column have not been disclosed in the specification. Note, the specification only discloses the payout based on symbols having respective determined positions which define a row."

Office Action, page 5

The rejection is improper for three reasons.

First, the record currently lacks any sort of evidence that the Examiner applied the proper test for enablement.

Second, the Examiner is incorrect in asserting that there is no disclosure of payouts being based on outcomes having respective positions which define a column.

Third, even if there were no such disclosure, one of ordinary skill in the art would not require undue experimentation to enable such an embodiment based on the present disclosure.

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1. Proper Enablement Test Not Applied

The Examiner must provide "those factors, reasons, and evidence that lead the examiner to conclude that the specification fails to teach how to make and use the claimed invention without undue experimentation". MPEP 2163.04

"In order to make a rejection, the examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. *In re Wright*, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993) (examiner must provide a reasonable explanation as to why the scope of protection provided by a claim is not adequately enabled by the disclosure)." MPEP 2163.04

"As stated by the court, 'it is incumbent upon the Patent Office, whenever a rejection on this basis is made, to explain *why* it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement. Otherwise, there would be no need for the applicant to go to the trouble and expense of supporting his presumptively accurate disclosure.' 439 F.2d at 224, 169 USPQ at 370." MPEP 2163.04

The only reasoning for the rejection provided by the Examiner is essentially that the literal language of the claim is not present in the portion of the specification entitled "Detailed Description". This is not, however, a factual finding that the specification would not teach one of ordinary skill in the art to make and use the claim without undue experimentation.

Valid claims can and often do cover embodiments that are not literally disclosed in the specification. In other words, lack of explicit disclosure in the specification does not necessarily make a claim invalid for, e.g., lack of enablement.

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"The examiner should never make the determination based on personal opinion. The determination should always be based on the weight of all the evidence." (emphasis in original). MPEP 2163.05

2. The Application Discloses the Column Embodiment

The claims as filed, including rejected claims 6, 19 and 20, form a portion of the disclosure. Thus, the claims as filed must be evaluated in determining whether the disclosure provides enablement for a claim.

The rejected claims, when read together with the remainder of the disclosure, teach one of ordinary skill in the art how to make and use the methods of claims 6, 19 and 20 without undue experimentation. Thus, those claims are enabled.

3. No Undue Experimentation is Required to Enable the Column Embodiment

The Examiner admits that the "row" embodiment is enabled. Office Action, page 5. From this "row" embodiment alone, one of ordinary skill in the art would not require undue experimentation to make and use many other embodiments, such as the "column" embodiment of rejected claims 6, 19 and 20.

If some experimentation is required to make and use the claim, that does not mean the claims are not enabled - only undue experimentation is impermissible. The Examiner must show why one of ordinary skill in the art would require undue experimentation to enable determining from a column.

The MPEP provides an example where some experimentation does not rise to the level of undue experimentation, and therefore the claims were enabled:

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"The question of time and expense of such studies, approximately \$50,000 and 6-12 months standing alone, failed to show undue experimentation."
MPEP 2164.06(i).

It is unclear whether the Examiner is alleging that the level of skill in the pertinent art is so low that knowledge of the row embodiment would not enable one of ordinary skill in the art to make and use the column embodiment. Applicants request that the Examiner provide concrete factual findings and explain the reasoning employed in the enablement rejection.

Since no *prima facie* showing of a lack of enablement has been made, Applicants have no obligation to demonstrate enablement.

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Section 102 / 103 Rejections

Claims 1 - 20 stand rejected as either anticipated by, or obvious in light of, Baerlocher (U.S. Patent No. 6,319,124). Applicants traverse the Examiner's Section 102 rejection. There has been no *prima facie* showing that the claims are anticipated or obvious.

Independent Claim 1

The Examiner admits that Baerlocher does not disclose all limitations of claim 1 (Office Action, page 6 - "Baerlocher does not explicitly teach a slot machine game having a popcorn icon"). Thus, the Examiner admits that claim 1 is not anticipated.

With respect to the obviousness of claim 1, the Examiner provides no motivation in the prior art to make the proposed modification to Baerlocher. The Examiner merely asserts that it would be a "design choice". Whatever that may mean, it has no bearing on whether the prior art at the time of filing contained a suggestion to modify Baerlocher in the manner proposed.

Note that the motivation "to enhance slot machine attraction" is not a motivation in any reference, and more importantly is not, by itself, a motivation to make the proposed modification to Baerlocher.

Since the limitation of:

displaying an icon of a popcorn for each symbol

is not taught or suggested by the evidence of record, claim 1 cannot be obvious.

In addition, the limitation of:

displaying, for each symbol, an image which moves from a starting position to the respective determined position;

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is not taught or suggested by Baerlocher, and the Examiner has not even indicated any portion of Baerlocher that might suggest this limitation.

Since the Examiner has not provided any reference containing a motivation to modify Baerlocher in a manner that renders claim 1 obvious, there has been no *prima facie* showing of obviousness.

Independent Claim 2

Independent claim 2 recites:

displaying an image which moves from a starting position to the determined position

This limitation is not taught or suggested by Baerlocher, and the Examiner has not even indicated any portion of Baerlocher that might suggest this limitation. Accordingly, no *prima facie* showing of unpatentability has been made.

Independent Claim 12

Independent claim 12 recites:

displaying, for each symbol, an image which moves from a starting position to the respective determined position;

This limitation is not taught or suggested by Baerlocher, and the Examiner has not even indicated any portion of Baerlocher that might suggest this limitation. Accordingly, no *prima facie* showing of unpatentability has been made.

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Conclusion

For the foregoing reasons it is submitted that all of the claims are now in condition for allowance and the Examiner's early re-examination and reconsideration are respectfully requested.

Alternatively, if there remains any question regarding the present application or any of the cited references, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact Dean Alderucci at telephone number 203-461-7337 or via electronic mail at Alderucci@WalkerDigital.com.

Respectfully submitted,



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